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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,426	06/28/2001	Miguel N. Bermudez	042390.P11384	8964

Todd M. Becker
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER

FRANKLIN, JAMARA ALZAIDA

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/895,426

Applicant(s)

BERMUDEZ, MIGUEL N.

Examiner

Jamara A. Franklin

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-- The MAILING DATE of this communication appears on th cover sh t with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10 and 12-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10 and 12-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Acknowledgment is made of the amendment received on 2/26/04. Claims 10 and 12-18 are currently pending.

Claim Objections

1. Claim 18 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 10, 14, 15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 6,697,812) in view of Egan (US 6,273,986).

Martin teaches a method comprising:

reading a unique identifier stored on a component (col. 5, lines 5-15);

printing the unique identifier read from the component onto first and second labels; and

affixing the first and second labels to a component container into which the component

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is inserted (col. 6, lines 25-39);

the method wherein printing the unique identifier on the first and second labels comprises encoding the identifier in a bar code and printing the bar code on the labels (col. 2, lines 27-37); and

the method wherein reading the unique identifier of the component comprises reading an electronically encoded identifier from the component.

Martin lacks the specific teaching of removably affixing the first and second labels.

Egan teaches removably affixing a label (col. 6, lines 35-44).

One of ordinary skill in the art would have readily recognized that providing the Martin invention with the ability to functionally removably affix the first and second labels would have been beneficial for not making the label a permanent fixture on the component. Therefore, it would have been obvious, at the time the invention was made, to modify the Martin invention with the aforementioned element as taught by Egan.

4. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin/Egan as applied to claim 10 above, and further in view of Peltier (US 6,671,611).

The teachings of Martin/Egan have been discussed above.

Martin/Egan lacks the teaching of attaching the first label on a device in which the component is installed.

Peltier teaches attaching a label on a device in which the component is installed (col. 14, line 54-col. 15, line 3).

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One of ordinary skill in the art would have readily recognized that attaching a label on a device in which the component is installed would have been beneficial for providing a record as to which device a particular component may have been installed. Therefore, it would have been obvious at the time the invention was made, to modify the teachings of Martin/Egan with the aforementioned teaching of Peltier.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin/Egan as applied to claim 10 above, and further in view of Adams (US 4,585,254).

The teachings of Martin/Egan have been discussed above.

Martin/Egan lacks the teaching of the label being made of polyester.

Adams teaches labels made of polyester (col. 2, lines 44-49).

One of ordinary skill in the art would have readily recognized that label made of polyester are able to withstand wear and tear without substantially damage to the label. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Martin/Egan with the polyester label as taught by Adams to make the label durable.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin/Egan as applied to claim 10 above, and further in view of Freund et al. (US 6,088,212) (hereinafter referred to as 'Freund').

The teachings of Martin/Egan have been discussed above.

Martin/Egan lacks the teaching of the container as an electro-static discharge bag.

Freund teaches an electrostatic discharge bag (col. 5, lines 1-5 and col. 6, lines 24-28).

One of ordinary skill in the art would have readily recognized that an electro-static discharge bag is one of a variety of container that may benefit from a label being affixed thereto to allow one to recognize the contents of the bag. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Martin/Egan with the electro-static discharge bag of Freund.

Response to Arguments

7. Applicant's arguments, filed 2/26/04, with respect to the rejection(s) of claim(s) 10 and 12-18 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of 35 U.S.C. 103(a).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamara A. Franklin whose telephone number is (571) 272-2389. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jamara A. Franklin
Examiner
Art Unit 2876

JAF
May 14, 2004


KARL D. FRECH
PRIMARY EXAMINER